

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/851,113

REMARKS

Claims 1-8 and 10-15 are pending in the present application. As will be discussed below, Claim 9 has been canceled and the feature of the invention previously recited therein has been incorporated into Claim 1. No new matter has been added. Accordingly, entry of the present amendment is requested.

Claims 1-5, 7, 8 and 10-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,852,128 to Padmanaban *et al.* in view of U.S. Patent No. 5,627,006 to Urano *et al.*

Applicants respectfully traverse this rejection in view of the foregoing amendment. In particular, while not agreeing that the rejection is appropriate, Applicants have amended Claim 1 to recite “wherein compound (B) is present in an amount from 1 to 20 wt% based upon the solid contents.” This feature of the invention was previously recited in now canceled Claim 9. At page 4 of the Office Action, the subject matter of Claim 9 was indicated as allowable.

In view of the foregoing, Applicants respectfully submit that the present claimed invention is not rendered *prima facie* obvious by Padmanaban *et al.* in view of Urano *et al.* Accordingly, withdrawal of this rejection is requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

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APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 9 is canceled.

The claims are amended as follows:

1. (Amended) A positive radiation-sensitive composition comprising:
 - (a) a resin whose solubility in an alkali developer increases by the action of an acid;
 - (b) a compound that generates a carboxylic acid having a molecular weight of 100 or less upon irradiation with an actinic ray or a radiant ray;
 - (c) a surfactant; and
 - (d) a solvent,

wherein compound (b) is present in an amount of from 1 to 20 wt% based upon the solid contents.